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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,385	01/26/2004	Satoshi Okamoto	023174-0107	4571

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EXAMINER

YOON, TAE H

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 09/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/763,385	Applicant(s) OKAMOTO ET AL.	
	Examiner Tae H. Yoon	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10, 13, 16-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 13-22 of U.S. Patent No. 7,063,892. Although the conflicting claims are not identical, they are not patentably distinct from each other because the resin composition of said patent inherently possesses the instantly recited properties since the same polymer and high dielectric filler are used. Various liquid crystalline polyesters and high dielectric fillers are taught at cols. 3 and 4 and col.12, lines 1-26, respectively. Also, the recited formulae (I) and (II) seem to be non-universal (not well known in the art), and thus applicant has a burden to show otherwise.

Claims 1-10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 6, 7 and 8 of U.S. Patent No. 6,838,546. Although the conflicting claims are not identical, they are not patentably distinct from each other because the resin composition of said patent inherently possesses the instantly recited properties since the same polymer and high dielectric filler are used. Various liquid crystalline polyesters and high dielectric fillers are taught at cols. 3-5 and col. 9, lines 18-29, respectively. Also, the recited formulae (I) and (II) seem to be non-universal (not well known in the art), and thus applicant has a burden to show otherwise.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The examples in the specification recite various Tradenames for fillers, NPO-S, CFT-900, NF-120, N4700 and BT-335, but the nature of said fillers is not taught. Thus, it is unclear and applicant failed to describe said fillers adequately. Note that any

amendment with products brochures must accompany copies of product brochures published before applicant's invention.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 13, 16, 17 and 19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Walpita et al (US 5,962,122).

Walpita et al teach liquid crystalline polyester composition containing ceramics such as TiO₂ in abstract and at col. 2, lines 40-42. Said composition has very high dielectric constant and very low loss tangent at 1 GHz, col. 2, lines 57-59, and it would inherently possesses the instantly recited properties due to its very high dielectric constant and very low loss tangent. Various articles having a film of said compositions

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are taught at col. 5, lines 25-44, and meet the condenser of claim 19 absent further structural limitation and since the preamble has little probative value.

Also, the recited formulae (I) and (II) seem to be non-universal (not well known in the art), and thus applicant has a burden to show otherwise.

With respect to claim 17, an invention in a product-by-process is a product, not a process. See *In re Brown*, 459 F2d 531, 173 USPQ 685 (CCPA 1972) and *In re Thorpe*, 777 F2d 695, 697, 227 USPQ 964 (Fed. Cir. 1985).

Thus, the invention lacks novelty.

Claims 1, 3, 4, 13, 16, 17 and 19 are rejected under 35 U.S.C. 103(a) as obvious over Walpita et al (US 5,962,122) and Calundann et al (US 4,473,682).

Claim 4 further recites monomers for said liquid crystalline polyester over Walpita et al who teach various patents for said liquid crystalline polyester at col. 3, lines 34-38 including US 4,473,682. Calundann et al teaches such monomer combination at col. 3, lines 9-45.

It would have been obvious to one skilled in the art at the time of invention to utilize the liquid crystalline polyester obtained from combination of monomers taught by Calundann et al in Walpita et al since Walpita et al teach employing said liquid crystalline polyester of Calundann et al.

Claims 1, 3, 7, 8, 16, 17, and 19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Walpita et al (US 5,739,193).

Walpita et al teach liquid crystalline polyester composition containing ceramics in abstract. Said composition has very high dielectric constant and very low loss tangent at 1 GHz, col. 5, lines 1-3, and it would inherently possess the instantly recited properties due to its very high dielectric constant and very low loss tangent. Various articles having a film of said compositions are taught at col. 7, lines 28-49, and meet the condenser of claim 19 absent further structural limitation and since the preamble has little probative value. Polysulfone and polyether sulfone are taught at col. 4, line 8

Also, the recited formulae (I) and (II) seem to be non-universal (not well known in the art), and thus applicant has a burden to show otherwise.

With respect to claim 17, an invention in a product-by-process is a product, not a process. See *In re Brown*, 459 F2d 531, 173 USPQ 685 (CCPA 1972) and *In re Thorpe*, 777 F2d 695, 697, 227 USPQ 964 (Fed. Cir. 1985).

Thus, the invention lacks novelty.

Claims 1-13 and 16-19 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Okamoto et al (US 6,838,546).

Okamoto et al teach an aromatic liquid-crystalline polyester solution composition containing chlorine substituted phenol and a dielectric powder in claims 1 and 6-8.

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Various aromatic liquid-crystalline polyesters are taught at cols. 3-5. The group C⁵ on col. 5 would yield an aromatic polysulfone and combination (col. 5, lines 6-8) of said C⁵ and the middle group of C³ would an aromatic polyether sulfone. Said dielectric powder such as alumina or silicon carbide is taught at col. 9, lines 18-39. Also, casting of said solution on a substrate in obtaining a film is taught at col. 9, line 54 to col. 10, line 36 and in examples. The use of additional solvents such as methylene chloride is taught at col. 6, line 56 Condenser is taught in line 34.

Also, the recited formulae (I) and (II) seem to be non-universal (not well known in the art), and thus applicant has a burden to show otherwise.

With respect to claim 17, an invention in a product-by-process is a product, not a process. See *In re Brown*, 459 F2d 531, 173 USPQ 685 (CCPA 1972) and *In re Thorpe*, 777 F2d 695, 697, 227 USPQ 964 (Fed. Cir. 1985).

Thus, the invention lacks novelty.

Claims 1, 2 and 16-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dalton (US 3,442,699).

Dalton teaches masking coating formulation comprising barium titanate (high dielectric powder), solvent and a polymer and a coated substrate thereof in example 1.

Also, the recited formulae (I) and (II) seem to be non-universal (not well known in the art), and thus applicant has a burden to show otherwise.

With respect to claim 17, an invention in a product-by-process is a product, not a process. See *In re Brown*, 459 F2d 531, 173 USPQ 685 (CCPA 1972) and *In re Thorpe*, 777 F2d 695, 697, 227 USPQ 964 (Fed. Cir. 1985).

Thus, the invention lacks novelty.

Claims 1, 2, 7, 8 and 16-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Horn, III. et al (US 5,922,453).

Horn, III. et al teach a polymeric composition comprising a fluoropolymer, liquid crystalline polymer or poly(ethersulfone) or polysulfone and high dielectric powder (such as titanium dioxide, silica or silicon carbide) in abstract and at col. 3, lines 8-17 and 53-67. The high dielectric constant filler is discussed at col. 4, lines 5-32

Also, the recited formulae (I) and (II) seem to be non-universal (not well known in the art), and thus applicant has a burden to show otherwise.

With respect to claim 17, an invention in a product-by-process is a product, not a process. See *In re Brown*, 459 F2d 531, 173 USPQ 685 (CCPA 1972) and *In re Thorpe*, 777 F2d 695, 697, 227 USPQ 964 (Fed. Cir. 1985).


Thus, the invention lacks novelty.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Tae H Yoon
Primary Examiner
Art Unit 1714

THY/September 13, 2006